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Recommended Citation

Dina M. Pascarelli, *Electronic Rights: After Tasini Who Owns What, When? Tasini v. New York Times*, 8 DePaul J. Art, Tech. & Intell. Prop. L. 45 (1997)
Available at: <https://via.library.depaul.edu/jatip/vol8/iss1/4>

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CASE NOTES AND COMMENTS

ELECTRONIC RIGHTS: AFTER *TASINI* WHO OWNS WHAT, WHEN? *TASINI v. NEW YORK TIMES*¹

INTRODUCTION

It is an elementary principle of copyright law that one has only the rights to use a work that he or she acquires from the copyright holder or that are provided by the provisions of the Copyright Act.² Once a work is written, the original creator is authorized to control its use and re-use. The original creator may agree to submit the work for publication as a part of a collective work with worldwide distribution, exchanging rights for payment.³ When the work is fully exploited in one medium (e.g., print publications), the work may be further profitable in an alternate medium, such as electronic publications.⁴

In today's growing computer industry, with the advent of on-line databases and CD-ROM products, electronic media proves to be the latest vehicle for additional distribution.⁵ While consumers and retailers have prospered from this move into the computer world, the legislature has lagged far behind technology's progress.⁶ It is essential that the Copyright Act of 1976 be tested to determine

1. *Tasini v. New York Times*, 1997 WL 466520 (S.D.N.Y. Aug. 13, 1997).

2. David J. Loundy, *Electronic Database Providers Collect Court Decisions*, 143 CHI. DAILY L. BULL. No. 198, October 9, 1997.

3. NIMMER ON COPYRIGHT, § 2.03[A] (1997).

4. Jonathan Tasini, *Tasini v. New York Times* (last modified August 14, 1997) <<http://www.igc.apc.org/nwu/tvt/tvthome.htm>>.

5. *Id.*

6. *Tasini vs. The New York Times, What Does It Mean For Writers?* (last modified August 23, 1997) <<http://www.igc.apc.org/nwu/tvt/tvtwrit.htm>>.

if it can accommodate the conflicts that arise in the modern world of computers.⁷ The limitations of the Copyright Act of 1976⁸ (hereinafter “the Copyright Act” or “the Act”) were recently articulated in *Tasini v. New York Times*. In *Tasini*, the court was asked to determine what rights are granted by a freelance writer who submits an article to be published in a collective work⁹ and who may profit when that collective work is reproduced electronically and introduced to the lucrative computer medium. This note will examine the facts and relevant sections of the Copyright Act necessary to address these concerns.

TASINI V. NEW YORK TIMES

I. Facts

In December of 1993, Plaintiffs, a group of freelance journalists, filed a complaint against prominent print publishers and electronic service providers.¹⁰ The journalists alleged that the electronic reproduction of print publications that included their articles constituted copyright infringement when such electronic copies were created without the expressed permission from the authors of the individual articles.¹¹ The plaintiffs did not contest the right of the defendants to publish the articles as a part of a collective work, but alleged that the defendants exceeded their narrow privilege under the Copyright Act.¹² The defendants responded by invoking the “revision” privilege of the “collective works” provision of the Act.¹³ The defendants maintained that as copyright owners of a collective work, the Act affords them the ability to make revisions to the work as a whole without disrupting the integrity of the individual works.¹⁴ It is this integrity that the plaintiffs claimed to

7. *Id.*

8. 17 U.S.C. § 101 *et seq.* (1997).

9. *Tasini*, 1997 WL 466520, at *3.

10. *Id.* at *4.

11. *Id.* at *2.

12. *Id.* at *5.

13. 17 U.S.C. § 201(c).

14. 17 U.S.C. § 204(b).

be not only disrupted, but also destroyed through the defendant's practice of electronic republication.¹⁵

On August 13, 1997, in *Tasini v. New York Times*, the court had its first opportunity to evaluate the role of copyright in electronic publishing.¹⁶ The Act was closely scrutinized by the court in order

to determine if the traditional concepts of print and film copyright law can be accurately translated to the relatively uncharted territory of electronic copyright law.¹⁷ In *Tasini*, Judge Sonya Sotomayer considered whether publishers were entitled to place the contents of their periodicals on electronic databases and CD-ROMs without first securing the permission of the freelance writers whose contributions are included in those periodicals.¹⁸ This analysis required the court to evaluate § 201(c) of the Copyright Act, in conjunction with the interpretation of § 204(a) and § 103(b), to determine if, explicitly or implicitly, the transformation of hard copy to electronic copy constitutes a "revision" as a publisher privilege.¹⁹ For the electronic media industry, Judge Sotomayer's ruling in favor of the publishers' summary judgment motion, "is a plea that the section is unclear and Congress should fix it."²⁰

II. The Parties

A. Plaintiffs

The plaintiffs are all members of the National Writer's Union (NWU), with Jonathan Tasini, the lead plaintiff being the president of the organization.²¹ NWU is an organization that represents approximately 4,500 freelance journalists, book authors, poets,

15. *Tasini*, 1997 WL 466520, at *5.

16. *Id.* at *3.

17. Meg Carter, *The Copyright Cases from Washington to Shetland*, THE INDEPENDENT (LONDON), August 26, 1997, at N10.

18. *Tasini*, 1997 WL 466520, at *2.

19. *Id.* at *3.

20. *Id.* at *2.

21. *Writers Win Major Points, Lose on Strange Interpretation of Copyright Law* (last modified August 14, 1997) <<http://www.igc.apc.org/nwu/tvt/tvtstate.htm>>

technical writers and editorial cartoonists.²² Tasini articulated the importance of their claims as follows:

For decades, when freelance writers sold stories to American publications, it was understood by all concerned that they were selling only First North American Serial rights which allowed the newspaper or magazine to publish the story in print one time. For freelance authors, retention of all other copyrights is crucial to their economic survival because significant additional source of income comes from their ability to sell secondary rights such as syndication, translations and anthologies.²³

B. Defendants

Four of the defendant companies, The New York Times (the “Times”), Sports Illustrated, Newsday, and The Atlanta Monthly are major players in the publishing industry who, at the time of the suit, employed varying writer-publisher contractual practices.²⁴ Generally, the freelance writer entered into a contract, either orally, partially written or entirely written. Despite their differences, all the contracts commonly lacked the explicit grant of electronic rights.²⁵ The Atlanta Monthly settled with the plaintiffs before trial. The remaining defendants argued that they solicited work from the plaintiffs through legal and ordinary publication channels, and thus they were granted the electronic right.²⁶ Before this litigation, the Times customarily hired freelance writers through entirely verbal agreements.²⁷ The editor and freelance writer would meet to determine the length, topic, deadlines and payment for

22. *Collective Copyright Licensing to Benefit Individual Photographers, Artists, and Writers* (last modified May 3, 1997) <<http://www.igc.apc.org/nwu/anc/nwu-asmp.htm>>.

23. Jonathan Tasini, *Tasini v. New York Times* (last modified August 14, 1997) <<http://www.igc.apc.org/nwu/tvt/tvthome.htm>>.

24. *Tasini*, 1997 WL 466520, at * 1.

25. *Id.*

26. *Id.* at *24 n. 1.

27. *Id.* at *2.

each article.²⁸ Neither party relied on a written contract to enforce the duties or formal obligations.²⁹ Recently however, the Times adopted a policy where the paper only accepts articles upon express written surrender of all rights in the author's creation, now called "All Rights" contracts.³⁰

The two additional defendants, Lexis-Nexis ("Nexis") and University Microfilm Inc. ("UMI"), (collectively, "Electronic Publishers"), operate online publication companies. Electronic Publishers' role in the alleged copyright infringement is a result of their actions directed from the print publishers in the exercise of their right to reproduce the collective works electronically.³¹ Nexis has carried the plaintiffs' articles since the early 1980's and serves as a resource to search and view periodical works from a computer terminal.³² Nexis received "mechanicals" which resembled full pages as they would appear at publication of the writers' contributions, but only used the text of the article, its author and page location in the initial collective work.³³ UMI has distributed "The New York Times OnDisc" since 1992.³⁴ It reproduces the entire Times publication on CD-ROM and sells it to consumers. The Times OnDisc references each individual article in its system with a link to the issue, date and page of the print publication in which the article originally appeared.³⁵

28. *Id.* at *8.

29. *Tasini*, 1997 WL 466520, at *8.

30. *Id.* at *24 n. 2. The New York Times has recently adopted a policy pursuant to which the paper accepts articles by freelance writers only on the express written condition that the authors surrender all rights in his or her creation. *Id.*

31. *Id.* at *6.

32. *Id.* at *3.

33. *Id.* The defendant publishers deliver or electronically transmit to Nexis the full text of all of the articles appearing in each daily or weekly edition of their periodicals. The publishers provide Nexis with a complete copy of computer text files that the publishers use during the process of producing the hard copy versions of their periodicals. The "mechanicals" resemble full pages as they will appear at publication. Nexis does not use the electronic files to create the "mechanicals" or to emulate the physical layout of each issue, but uses the electronic files to impute the contents of each article on-line along with the author's name, the publication and page in which each article appeared. *Id.*

34. *Tasini*, 1997 WL 466520, at *3.

35. *Id.* at *4.

III. Scope of the Publisher's Privilege to Reproduce

The defendants contended that as publishers, they were afforded copyright protection for their collective work as a whole.³⁶ The defendants claimed that the transfer of certain sticks within the plaintiffs' bundle of rights was permissible and governed by Copyright Law.³⁷ The legal transfer of individual rights from writer to publisher is classified as a privilege which bestows certain rights to re-use original works at the publisher's discretion.³⁸ One such privilege is the ability for the publisher of a collective work to make revisions.³⁹ It is the length to which a publisher may go in creating revisions which is at dispute, specifically whether electronic republications are permissible under the privilege.

The writers allege that the transfer of North American Rights of First publication, understood in their contracts with the defendants and in the absence of the electronic rights language, did not permit the publisher to profitably exploit the writer's work without his subsequent permission.⁴⁰ This problem can be attributed to the traditional practices of the publishing industry where parties do not negotiate the details of the contracts for freelance employment.⁴¹ Not only must the court determine what rights were transferred in the oral contracts, but also the limitations of the exercise of those rights.

Since the Times did not use written contracts at all, we turn to Newsday's practices to examine the language of the contracts.⁴² Newsday's editors orally discussed the details of the writer's engagement with the publisher and, upon agreement, a check was

36. *Id.*

37. *Id.* at *3.

38. 17 U.S.C. § 103(a). The subject matter of copyright as specified in the Copyright Act includes compilations and derivative works. Furthermore, § 201 grants original authors the right to transfer the ownership rights of their individual works or any subdivision of rights inherent in the copyright ownership they possess. 17 U.S.C. § 201.

39. 17 U.S.C. § 103(b).

40. *Tasini*, 1997 WL 466520, at *1.

41. Richard Raysman & Peter Brown, *Electronic Data Bases and Rights of Freelancers*, 218 N.Y.L.J. 49, at 2, (1997).

42. *Tasini*, 1997 WL 466520, at *2.

given to the writer in exchange for his contribution.⁴³ The check's endorsement appeared on the back of the check and included the explicit grant of First Time publication rights to the publisher. Upon receipt, *Tasini* crossed out the endorsement when cashing the check, while the other writers cashed it with the endorsement intact.⁴⁴

Solicitations for employment by *Sports Illustrated* publishers were more formal.⁴⁵ *Sports Illustrated's* contracts included an explicit grant of First Publication rights and the right to re-use the article with additional compensation to the writer. However, these contracts lacked the explicit language to grant the publishers the right to reproduce the article electronically.⁴⁶ Whether such a grant can be implied embodies the basic issue of the court's analysis. The defendants argued that the Copyright Act implicitly encompasses the electronic publication rights referred to in oral or loosely written contracts between freelance writers and publishers. *Tasini*, as the landmark case regarding publishing in the computer age, has the opportunity to establish whether the author of an article who submits his work to be included in a periodical, forfeits the ability to be compensated when that periodical is subsequently published electronically.⁴⁷

IV. Holding in Tasini.

As a case of first impression for the court, Judge Sotomayer ruled on the parties' respective motions for summary judgment. The court held in favor of the defendants, finding as a matter of law, the electronic re-use of the plaintiff's articles constituted a revision as allowed under § 201(c) of the Copyright Act.⁴⁸ It also recognized that this interpretation of § 201(c) created a windfall to the publishers and signifies that the current legislation may

43. *Id.*

44. *Id.* at *2.

45. *Id.*

46. *Id.*

47. *Tasini v. The New York Times and the Free Flow of Information* (last modified January 11, 1997) <<http://www.igc.apc.org/nwu/tvt/tvtlib.htm>>.

48. *Tasini v. The New York Times and the Free Flow of Information*, at *4.

inadequately accommodate advancements in modern technology.⁴⁹ In denying the plaintiffs relief at this junction, the opinion brings the issue to the hands of the legislature.⁵⁰ Being such a timely issue in today's world of communication and technology, *Tasini's* final outcome has industry wide ramifications affecting writers, publishers and electronic media companies.

THE COPYRIGHT ACT

The sections of the Copyright Act pertinent to *Tasini* and Judge Sotomayer are § 204(a), § 101, § 201(c) and § 103(b).⁵¹ Through the discussion of these fundamental rights of copyright law, it is possible to follow Judge Sotomayer's systematic analysis of the plaintiffs' allegations and understand the court's holding in favor of the defendants. It is crucial that these elements are understood before discussing the importance of their interaction in the case.

I. Section 201(c)

A. Rights Afforded to Authors of Copyrighted Collective Works.

Section 201(c) bestows certain rights to copyright owners of collective works.

Copyright in each separate contribution to a collective work is distinct from copyright in the collective works as a whole, and vest initially in the author of the contribution. In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as part of that particular collective

49. *Tasini vs The New York Times, What Does it Mean for Writers?* (last modified August 23, 1997) <<http://www.igc.apc.org/nwu/tvt/tvtwrit.htm>>.

50. *Id.*

51. *Tasini*, 1997 WL 466528 at *94.

work, and any later collective work in the same articles.⁵²

The complexity of the role of § 201(c) in the publishing industry is best understood by examining the implications of its components.⁵³ The first sentence states that the author of the individual contribution in a collective work retains all copyrights as its creator.⁵⁴ In its second sentence, § 201(c) extends to all publishers of collective works the privilege of “reproducing and distributing ...any revision of that collective work.” It is the scope of these privileges wherein the *Tasini* dispute lies.⁵⁵ One who assembles an independent work “into a collective whole” becomes the author of the collective work and is consequently entitled to copyright protection. The author of a collective work is privileged to “reproduce and distribute each contribution as a part of that collective work, any revision of that collective work, and any later collective work in the same series.”⁵⁶ Section 201(d)(2) of the Copyright Act expressly provides for the divisibility of copyrights and for copyright owners to transfer all or part of any exclusive right granted under the Copyright Act.⁵⁷ Accordingly, the transferee of the copyright, or a related exclusive right, will be treated as the owner of the copyright, although the nature of the transferee’s rights in the work will depend upon the scope of the transferor’s grant of rights.⁵⁸

In the absence of an express transfer of the copyright or of any rights under it, the owner of copyright in the collective work is presumed to have acquired only the privilege of reproducing and distributing the contribution as a part of that particular collective work, any revision of that

52. 17 U.S.C. § 201(c).

53. *Tasini*, 1997 WL 466520, at *10.

54. *Id.*

55. *Id.*

56. NIMMER, *supra* note 3, § 5.02.

57. 17 U.S.C. § 201(d)(2) (“Any exclusive rights comprised in a copyright, including any subdivision of any rights, may be transferred...and owned separately.”).

58. NIMMER, *supra* note 3, § 5.07[C].

collective work, any later collective work in the same series.⁵⁹

B. In Tasini

The plaintiffs allege that not only were the defendant publishers directly liable for the infringement of their electronic rights, but were also contributorily liable due to the electronic database companies re-use of the articles bought from the print publishers.⁶⁰ The plaintiffs also insisted that the grant of rights was limited to the “North American Rights of first publication.”⁶¹ Nevertheless, the defendants maintained that the practice of electronically reproducing the plaintiff’s articles was authorized under § 201(c) and they merely generated revisions of their rightfully owned copyrighted collective work.⁶²

II. Section 204(a)

A. Elements of an Effective Transfer of Original Copyrights

Requiring a written transfer of individual copyright between parties is often referred to as the copyright “statute of frauds” and is strictly enforced by the courts.⁶³ Under § 204 (a):

[A] transfer of copyright ownership (other than one brought by operation of law) is valid only if there exists an instrument of conveyance, or alternatively a “note or memorandum of the transfer” which is in writing and signed by the copyright owner “or such owner’s duly authorized agent.”⁶⁴

59. 17 U.S.C. § 201(c).

60. *Tasini*, 1997 WL 466520, at *10 n. 3.

61. *Id.* at *11.

62. *Id.* at *1.

63. NIMMER, *supra* note 3, § 106[B][2].

64. *Tasini*, 1997 WL 466520, at *13.

In order for a transfer of copyright ownership to be valid, the agreement between parties must comport with this section of the Copyright Act.⁶⁵ Through a broad reading of this writing requirement, “a writing memorializing the assignment of copyright interests does not have to be the Magna Carta; a one-line pro forma statement will do.”⁶⁶ However, the terms of any writing purporting to transfer copyright interests, even a one-line pro forma statement, must be clear.⁶⁷ A written contract is not necessary for the transfer of rights from employee author to employer publisher as a result of the work-for-hire doctrine, constitutes as automatic transfer by operation of law.⁶⁸ This distinction between work-for-hire and freelance engagements need not be discussed, however, since neither party claimed the work in question was for hire.

B. In Tasini

Newsday argued that an express transfer of electronic rights occurred when the plaintiffs signed the endorsements and cashed the checks.⁶⁹ The court applied § 204(a) and its plain meaning to agree that the writers and publishers had an understanding; the writers relied on the oral agreements, submitting their works in exchange for future payment.⁷⁰ The endorsement reads as follows:

Signature required. Check void if this endorsement altered. This check accepted as full payment for the first-time publication rights (or all right, if this agreement is for all rights) to material described on the face of check in all editions published by Newsday and for the right to include such material in electronic library archives.⁷¹

65. 17 U.S.C. § 204(a).

66. *Papa's June Music, Inc. v. McLean*, 921 F. Supp. 1154, 1158-1159 (S.D.N.Y. 1996) (citing *Effects Associates, Inc. v. Cohen*, 908 F.2d 555, 557 (9th Cir. 1990)).

67. *Id.*

68. NIMMER, *supra* note 3, § 10.03 [A].

69. *Tasini*, 1997 WL 466520, at *6.

70. *Id.*

71. *Id.*

Newsday claimed that the plaintiffs' action in endorsing and depositing the payment evidenced their understanding and agreement to transfer the electronic rights.⁷² Judge Sotomayer's response: "[T]hat is not enough."⁷³ The court explained that check legends alone are ambiguous and cannot be taken to reflect an express transfer of electronic rights in the plaintiffs' articles.⁷⁴ Although the court agreed with Newsday that a written agreement might be executed to confirm a prior oral agreement, it rejected Newsday's attempt to take advantage of the law's flexibility by using the check endorsement to expressly grant rights beyond the original parties' understanding.⁷⁵ Even if the endorsement was enforceable, the endorsement only claimed the right to use the plaintiffs' articles in Newsday's in-house electronic library archives.⁷⁶

Behold the plaintiffs' most persuasive argument. Their assertion that "electronic library archives" do not encompass the use for the electronic databases outside the initial publishing company (e.g., Nexis or CD-ROMs) was accepted by Judge Sotomayer.⁷⁷ The court held the defendants' right to re-use the articles for in-house archives could be reasonably interpreted from the endorsement, but could not serve as an umbrella protection for the defendant to sell the articles to commercial databases.⁷⁸ The electronic "repackaging" of the plaintiffs' articles was for wholly different purposes than the creators had anticipated. Both parties conceded that the library archives mentioned in the endorsement referred to Newsday's in-house archival system, which bore no commercial advantages. Thus, the court used §204 to determine that Newsday endorsements could not be interpreted, as a matter of law, to represent the unequivocal and timely transfer of electronic rights of the plaintiffs' articles.⁷⁹

72. *Id.*

73. *Id.* at *15.

74. *See Playboy Enterprises, Inc. v. Dumas*, 53 F.3d 549, 564 (2d. Cir. 1996).

75. *Tasini*, 1997 WL 466520, at *6.

76. *Id.*

77. *Id.* at *15.

78. *Id.* at *7.

79. *Id.* at *16.

III. Section 103(b)

A. The Distinction Between a Collective work as a type of Compilation and a Derivative Work

Section 103(b) provides:

The copyright in a compilation or derivative work extends only to that material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such work is independent of, and does affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.⁸⁰

Section 103(b) protects collective and derivative works under the Copyright Act.⁸¹ These two separate types of copyrightable works are commonly based on preexisting works.⁸² “Both collective works and derivative works are based upon preexisting works that are in themselves capable of copyright.”⁸³ Where a derivative work “transforms” a preexisting work into a new creation, a collective work consists of numerous original contributions, which are not altered, but are assembled to create an original collective whole.⁸⁴ The collective work is copyrightable as a new work due to the creativity in the work’s arrangement.⁸⁵ However, the copyright of a collective work does not affect or enlarge the scope, duration, ownership, or subsistence of any copyright protection in the

80. 17 U.S.C. § 103(b).

81. *Id.*

82. NIMMER, *supra* note 3, § 3.02.

83. *Tasini*, 1997 WL 466520, at *8.

84. 17 U.S.C. § 101. See *Feist Publications, Inc. v. Rural Telephone Service, Co.*, 499 U.S. 340 (1991) (holding that to qualify for a separate copyright as a “derivative work,” the additional matter injected into a prior work must constitute more than a minimal or trivial contribution).

85. 17 U.S.C. § 101.

preexisting material.⁸⁶ Specifically, copyright in a “new version” covers the material added by the later author and has no effect on the copyright or public domain status of the preexisting material.⁸⁷

B. Tasini

Following the Supreme Court’s lead, Judge Sotomayer illustrated the contemporary stand on “new property rights” created in collective and derivative works.⁸⁸ In *Stewart v. Abend*, the author of a fictional story agreed to assign the rights in his renewal copyright term to the owner of a movie version of that story, but died before the commencement of the renewal period.⁸⁹ The assignment never occurred, and it was held that the defendant infringed the copyright of the successor owner of the story by continuing to distribute the film during the renewal term of the preexisting work.⁹⁰ The Supreme Court said that an assignment of renewal rights to a copyrighted fictional story for the distribution of a movie version is not an assignment of the original owner’s rights to a derivative or collective work.⁹¹ Therefore, subsequent distribution of the film during the renewal period, absent the original owner’s permission of the copyright, constituted infringement and did not preclude the owners from enforcing his rights.⁹² Furthermore, “so long as the preexisting work remains out of the public domain, its use is infringing if one who employs the work does not have a valid license or assignment for use of the preexisting work. It is irrelevant whether the preexisting work is inseparably intertwined with the derivative work.”⁹³ Under §103(b), any unauthorized use of the preexisting protected material by the creator of a derivative or collective work, infringes the copyright existing in the preexisting material.⁹⁴ In *Tasini*, the court held that the electronic reproductions of the print-publications

86. 17 U.S.C. § 103(b).

87. *Tasini*, 1997 WL 466520, at *9.

88. *Stewart v. Abend*, 495 U.S. 207 (1990).

89. *Id.*

90. *Tasini*, 1997 WL 466520, at *10.

91. *Abend*, 495 U.S. at 219.

92. *Tasini*, 1997 WL 466520, at *22.

93. *Abend*, 495 U.S. at 223-24.

94. *Tasini*, 1997 WL 466520, at *23.

qualified as “revisions” under § 201(c) of the Copyright Act. Therefore, the print-publishers could employ Nexis and UMI to create the electronic reproductions and were not limited to reproductions in print media.⁹⁵

IV. The Court’s Analysis

Examined together, the *Tasini* court recognizes that, at first glance, § 201(c) and § 103(b) complement and enforce the Copyright Act’s interest in protecting original creator’s rights while encouraging the creation of new works.⁹⁶ However, with a closer reading of § 201(c), in part with (a) and (b), the rights to creators of collective works are enumerated as the “privilege of reproducing and distributing the contribution as a part of that particular collective work, any revision of that collective work and any later work in the same series.”⁹⁷ It is here, in the scope of copyright protection afforded to copyright owners of collective works, which is at issue in *Tasini*.

A. the Publisher’s Right to Reproduce

In light of Judge Sotomayer’s interpretation of the Copyright Act and in consideration of the court’s policies of copyright law, the plaintiffs’ argument failed.⁹⁸ The freelance writers contended that the right to make revisions of the collective works owned by the publishers was acceptable under the Copyright Act. The re-use and elicit reproductions by the defendants exceeded the boundaries interpreted and explained in § 201(c).⁹⁹ They argued the changes to the original works, in order to carry out the purpose of the collective work’s inclusion on CD-ROMs and online databases, destroyed the distinctive characteristic of the collective work.¹⁰⁰ The plaintiffs claimed that the nature in which the electronic

95. Raysman & Brown, *supra* note 41, at 6.

96. *Tasini*, 1997 WL 466520, at *10.

97. 17 U.S.C. § 201(c).

98. *Tasini*, 1997 WL 466520, at *18.

99. *Id.* at *19.

100. *Id.* at *18.

databases were created and offered to the public violated the principles of the fundamental copyright protection.¹⁰¹ The searches made available by the electronic defendants were designed with a coding system to retrieve individual articles out of context from the collective work in which it was originally published.¹⁰² For the convenience of the database users, articles were editorially supplemented to withstand this “out of context” appearance and displayed with headers which identified the author of the article, the publication and the page in which the article first appeared.¹⁰³

The plaintiffs read the privileges of § 201(c) narrowly to cover nonexclusive licenses, which unlike assignments and exclusive licenses, are non-transferable.¹⁰⁴ Relying on § 201(d),¹⁰⁵ the plaintiffs claimed that the electronic revisions of the defendants’ collective works constituted actionable infringement because the defendant publishers could only exercise the privileges of those rights validly transferred to them by the freelance writers.¹⁰⁶ In the absence of an explicit grant of rights, the plaintiffs argued that the defendants incorrectly assumed that the rights were transferred under the vague oral contracts and were not limited to the first time use in print publications.¹⁰⁷

Judge Sotomayer found no support in the Copyright Act for the plaintiffs’ contention that the “privilege” of § 201 should be read so narrowly.¹⁰⁸ Instead, the court cited Congress’ intention in drafting the Copyright Act to find that the Act simply would not have advanced its goal if publishers were constrained in their efforts to generate and distribute legal revisions and reproductions.

101. *Id.* at *19.

102. *Id.* at *21.

103. *Tasini*, 1997 WL 466520, at *21.

104. *Id.* at *11.

105. The provision states, in part, the following:

1) The ownership of a copyright may be transferred in whole or in part by any means of conveyance or by operation of law, and may be bequeathed by will as personal property by application of laws of intestate succession.

2) Any of the exclusive rights composed in a copyright, including any subdivision of any rights specified in section 106, may be transferred as provided by clause (1) to all of the protection and remedies accorded to the copyright owner by title. 17 U.S.C. § 201(d).

106. *Id.*

107. *Id.*

108. *Tasini*, 1997 WL 466520, at *10.

A narrow reading of the Act would not prevent the exploitation of individual contributions, but would only serve to undermine the competing goal of ensuring that collective works be marketed and distributed to the public.”¹⁰⁹

B. Interpretation of what constitutes a Revision.

The plaintiffs also argued that the New York Times OnDisc could not “reasonably be considered revisions of the publisher defendants’ periodicals because the significant elements periodical as a whole were not preserved electronically.”¹¹⁰ The OnDisc articles appeared without the photographs and in different page layouts than when originally published. The plaintiffs claimed that the CD-ROM reproductions plainly failed to reproduce the original arrangement of materials as they were first published.¹¹¹ Judge Sotomayer disagreed and said that by re-using the selection of plaintiffs’ articles, “the defendants have managed to retain one of the few defining original elements of the publisher’s collective works.”¹¹² Since publishers of collective works only own the arrangement of the entire work and the Copyright Act establishes that publishers can make revisions, the alteration or absence of the original “set up” is the only way a revision could be made.¹¹³ Therefore, if the electronic defendants carried recognizable versions of the periodicals in which the plaintiff writers originally agreed, the revision was not an infringement.¹¹⁴ Nexis and UMI carried recognizable revisions, and for the purposes of § 201(c) “the defendants have succeeded at creating any revision of those collective works.”¹¹⁵ In other words, where a compilation possessed both original arrangement and original selection to obtain copyright under law, a substantial similarity persists even when original arrangement was sacrificed.”¹¹⁶

109. *Id.* at *12.

110. *Id.* at *21.

111. *Id.*

112. *Id.*

113. *Tasini*, 1997 WL 466520, at *22.

114. *Id.*

115. *Id.*

116. *Id.*

In response to the plaintiffs' argument that the electronic reproductions did not qualify as revisions, the court was persuaded by the defendants' assertion that they were authorized to make any such revision.¹¹⁷ When traditional copyright provisions were applied to the electronic medium, inadequacies of the current Copyright Act became apparent. The Copyright Act was ratified in 1976 and operates in the context of microfilm and microfiche as the medium of re-use. Such an industry lacks the lucrative characteristic of the modern electronic information age.¹¹⁸ The *Tasini* court recognized a limit to the defendants' use and re-use of the plaintiffs' articles, but not to the extent suggested by the plaintiffs.¹¹⁹

First, the plaintiffs contended that the right to reproduce articles as a part of collective work did not include the right to exploit computer technologies, which, by their nature, require the display of the work.¹²⁰ Next, the plaintiffs claimed that the absence of the Copyright Act's explicit definition that a revision was allowed, implied the right to revise was not permitted. Fatally, however, the plaintiffs prematurely stopped their discussion of the right to reproduce and did not explain how reproduction of their work would be permitted.¹²¹ The court was forced to pick up where the plaintiffs left off. Judge Sotomayer reasoned, although reproduction is not defined separately under the Copyright Act, §106 reveals that reproductions inevitably resulted in "copies."¹²² The defendants capitalized on the opportunity to describe "copies," looking to § 101 of the Copyright Act.¹²³

‘Copies’ are material objects...in which a work is fixed by any method now known or later developed, and from which the work can be perceived,

117. *Id.*

118. Jeff Garigliano, *First Round in Electronic Publishing Rights Case Goes to Publishers*, FOLIO: THE MAGAZINE FOR MAGAZINE MANAGEMENT, 1997 WL 2006228, *1.

119. *Id.*

120. 17 U.S.C. § 106.

121. *Tasini*, 1997 WL 466520, at *12.

122. *Id.* at *13.

123. 17 U.S.C. § 101.

reproduced, or otherwise communicated, either directly or with the aid of a machine or device...¹²⁴

The court found the right to reproduce a work necessarily encompassed the right to create copies of the work and presupposed such copies might be perceived from a computer terminal.¹²⁵ The plaintiffs urged the court to consider the fact that the earlier versions of the Copyright Act granted publishers the right to publish the works, including distribution, public performance and public display.¹²⁶ The plaintiffs concluded that the absence of this grant in the final version of the Act served to deny the publishers this right.¹²⁷ The court was unwilling to interpret the absence of such language in the final version of the Copyright Act as an intentional omission that should be given greater weight than afforded in the final Act.¹²⁸ Thus, in accordance with the Copyright Act, the court determined that as long as the defendants operated within the scope of their privilege to reproduce and distribute the plaintiff's articles, incidental display of those individual contributions did not violate any explicit section of the Act.¹²⁹

C. The Right to Reproduce a Collective Work.

Judge Sotomayer's holding comports with the Supreme Court's concern that the "creators of factual compilation and collective works derive their rights solely from their original contributions, and [should] not be permitted to usurp complete control over the

124. *Id.*

125. *Tasini*, 1997 WL 466520, at *13.

126. *Id.* at *12. Plaintiffs refer to Section 106 of the Act, which lists the five exclusive rights, (the "bundle" of rights), constituting a copyright. The "reproduction" privilege identified under Section 201(c), as plaintiffs note, invokes the right "to reproduce the copyrighted works in copies or phonorecords." Section 201(c) does not, however, implicate the distinct right to display the copyrighted work publicly.

127. *Tasini*, 1997 WL 466520, at *13.

128. *Id.*

129. *Id.*

component parts of their creation.”¹³⁰ The judge found that the defendants protected the original selection of articles when they electronically reproduced and adequately maintained the integrity of the collective work, resulting in the acceptable revision of the original publication.¹³¹ Articles that are included on the Nexis database include the minimal “certain percentage” of the articles selected by the defendant.¹³² Under this “percentage” standard employed by the court, the Electronic Publishers’ reproduction of the Times publication was an acceptable revision on Nexis because they were authorized to do so by the print publishers.¹³³ The court found that this immersion into a larger database did not automatically destroy the original published work.”¹³⁴ The defendants avoided this risk by displaying the articles electronically and maintaining the connection to the newspaper or periodical in which it first appeared.¹³⁵ The court found that this link back to the original publication enhanced the value of the article individually, because an article’s association with certain periodicals potentially enhances the value of that article.¹³⁶ “Indeed, an article appearing in Newsday or the Times is instantly imbued with a certain degree of credibility that might not exist in the case of an article never published or an article published in other periodicals.”¹³⁷

Furthermore, the court found that the traits lost during the transfer of the plaintiffs’ articles from hard copy to the electronic reproductions were of only peripheral concern.¹³⁸ The purpose of §201(c) is “to avoid the exploitation of individual articles, and not to prevent publishers from reworking their collective work in significant ways. Congress determined that publishers should have the leeway to preserve certain original aspects of their creation

130. See 17 U.S.C. § 103(b); NIMMER, *supra* note 3, at 3-20-21 (stating only that which is original with the copyright proprietor or his assignor may be protected by his copyright).

131. *Tasini*, 1997 WL 466520, at *22.

132. *Id.* at *20.

133. *Id.*

134. *Id.*

135. *Id.*

136. *Tasini*, 1997 WL 466520, at * 24 n. 14.

137. *Id.*

138. *Id.* at *21.

while discarding others.”¹³⁹ It is up to the courts to support the law, thus being responsible for protecting this leeway until such law is changed. Accepting that Congress constructed §201(c) to empower publishers to create “any revision” of their collective works, the court is then only called upon to determine whether the electronic reproductions are different from the defendants’ collective works.¹⁴⁰

The plaintiffs also alleged that the defendants’ right to reproduce the collective work was confined by a narrow scope that was limited to the examples of revisions included in the Copyright Act.¹⁴¹ Namely, the defendants’ reproduction via electronic databases and CD-ROM encyclopedias was outside the intention of Congress. They provided a passage of the House Report on the matter.¹⁴² The section of the House Report referred to by the plaintiffs is as follows:

Under the language of this clause a publishing company could reprint a contribution from one issue in a later issue of its magazine, and could reprint an article from a 1980 edition of an encyclopedia in a 1990 revision of it; the publisher could not revise the contribution itself or include it in a new anthology or an entirely different magazine or other collective work.¹⁴³

The court regarded the encyclopedia example as so outside the realm of today’s technology that it was nearly obsolete.¹⁴⁴ Under the language of §201(c) and its legislative history, the court could not reasonably interpret the Copyright Act as being overly media restrictive.¹⁴⁵ Upon a closer examination of the language of this section, it contained no express limitation upon the medium in which a revision can be created.¹⁴⁶ “To the contrary, ‘any revision’

139. *Id.* at *22.

140. *Id.*

141. *Tasini*, 1997 WL 466520 at *14.

142. *Id.*

143. H.R. REP. NO. 1476, 94th Cong., at 122-23 (1976).

144. *Tasini*, 1997 WL 466520, at *14.

145. 17 U.S.C. § 201(c).

146. *Id.*

of a collective work is permissible, provided it is a revision of ‘that collective work.’”¹⁴⁷ The plaintiffs claimed that Congress was unaware of computer technologies that would change the way publishers reproduced their collective works and intentionally omitted such a provision in § 201(c). Judge Sotomayer found it was more accurate to say Congress was aware of such technologies, “but did not fully understand the implications of the computer technologies.”¹⁴⁸

Upon ratification of the Copyright Act, Congress recognized its inability to resolve the complicated issues concerning the technological advancements of the computer era.¹⁴⁹ Congress felt the cause would be better served after an organized study was conducted.¹⁵⁰ The National Commission on New Technological Uses of Copyrighted Works (“CONTU”) carried out the task in 1980.¹⁵¹ Upon CONTU’s review, Congress repealed the original §117 of the Copyright Act which addressed the “implications of automatic systems capable of storing, processing, retrieving, or transferring information” because it was unnecessary to limit the medium in which a revision can be created under § 201(c).¹⁵² The court was not persuaded by the plaintiffs’ argument that Congress removed § 117 because such a transformation would not constitute a revision, but would create an entirely new work. Without an expressed transfer of the right to create derivative works from the original author, any such creation was an act of copyright infringement.¹⁵³

Alternatively, the court found Congress’ initial consideration of the need to include a separate section governing electronic reproduction was a strong indication that the final enacted version, absent the provision, encompassed future electronic and developing technologies.¹⁵⁴ As a result, the court concluded “no

147. *Tasini*, 1997 WL 466520, at *14.

148. *Id.* at *14 (citing Arthur R. Miller, *Copyright Protections For Computer Programs, Databases, And Computer Generated Works: Is Anything New Since CONTU?*, 106 HARV. L. REV. 977, 979 (1993)).

149. *Tasini*, 1997 WL 466520, at *14.

150. *Id.*

151. *Id.*

152. 17 U.S.C. § 117.

153. *Tasini*, 1997 WL 466520, at *15.

154. *Id.*

remaining reason to foreclose the possibility of an electronic ‘revision’ of a collective work.”¹⁵⁵ Following the defendants’ arguments, the court determined the Copyright Act was crafted with the goal of media neutrality and in a technologically forward looking manner.”¹⁵⁶ Furthermore, the definitions of the terms in §101, are constructed broadly to accommodate and adapt to the new advancing media.¹⁵⁷ In sum, the defendants’ assertion that Congress did not intend for the interpretation of the terms “reproduction” and “revision” to be radically different from the media neutral characteristic prevalent throughout the Copyright Act was sound.¹⁵⁸

D. Electronic Publication of a Collective Work is an Acceptable Revision.

Plaintiffs complained that defendants not only failed to preserve their collective works, but they also actively dismantled those works.¹⁵⁹ Upon further examination of each use by the Electronic Publishers, there was a distinction that the court found controlling.¹⁶⁰ This distinction articulated another important step in understanding the reasoning of the court’s final holding.

Employing an approach typically used in the evaluation of infringement claims pertaining to factual compilations, Judge Sotomayer implemented a two step process.¹⁶¹ This approach began with the identification of an original trait in the individual work, requiring a sufficient preservation of that trait in the subsequent revision.¹⁶² Infringement commonly occurs when that original trait is copied in a “revision” of that compilation. Alternatively, in the context of collective works, the preservation

155. *Id.*

156. *Copyright Law Revision: Hearing on H.R. 4347, 5680, 6831, 6835 Before Subcommittee No. 3 of the House Committee on the Judiciary*, 89th Cong., 1st Sess. 57 (1965).

157. 17 U.S.C. § 101.

158. *Tasini*, 1997 WL 466520, at *15.

159. *Id.*

160. *Id.* at *18.

161. *Id.*

162. *Id.* at *19.

of the original trait does not reach the same conclusion.¹⁶³ “If the disputed periodicals manifested an original selection or arrangement of materials, and if that originality was preserved electronically, then the electronic reproductions can be deemed a permissible revisions of the defendant’s collective works.”¹⁶⁴ The court determined the exploitation of the author’s work without preserving the sense of being a part of an entire work results in the infringement and is an unacceptable re-use as a revision.¹⁶⁵

Before addressing the specific facts of *Tasini*, Judge Sotomayer explained the Court’s understanding of the term “revision” in the context of collective works.¹⁶⁶ The plaintiffs insisted that, by its plain meaning, a “revision” must be nearly identical to the original.¹⁶⁷ The court disagreed, finding nowhere in the Copyright Act support for this assumption.¹⁶⁸ The rule derived from the language of the Act convinced the court that a revision could alter a preexisting work through editorial revisions by a sufficient degree to give rise to a new original creation.¹⁶⁹ The limitations embodied in the language of § 201(c) permitted the publishers to “reproduce an individual contribution “as a part of ... any revision” of the collective work in which it initially appeared.”¹⁷⁰ Contrary to the Plaintiffs’ assertion of what constitutes an authorized reproduction under § 201(c), the court held that the reproduction of a collective work supported Congress’ intent to prevent publishers from altering or reshaping the content of individual articles.¹⁷¹ “With this limitation in place, Congress apparently was willing to permit publishers significant leeway.”¹⁷² It seems that Judge Sotomayer did not realize the weight of this comment in light of the case holding, because it is this leeway that has the greatest impact on the outcome of the case. It was the goal of the plaintiffs

163. *Tasini*, 1997 WL 466520, at *19.

164. *Id.*

165. *Id.* at *20.

166. *Id.*

167. *Id.* at *16.

168. *Tasini*, 1997 WL 466520, at *16.

169. 17 U.S.C. § 101.

170. 17 U.S.C. § 201(c).

171. *Tasini*, 1997 WL 466520, at *16.

through this suit to curtail, control and possibly even eliminate this privilege.¹⁷³

The publishers, as copyright owners of collective works, prevailed in the court's interpretation of the Copyright Act.¹⁷⁴ The Act articulates that a compromise was previously reached between authors and publishers. The two parties were comfortable permitting broad discretion in revising their collective works, provided those individual articles would remain in tact.¹⁷⁵ More importantly, the "key limitation imposed on publishers under §201(c) rests in the fact that publishers are only permitted to reproduce a particular article as a part of a revised version of the collective work in which that article originally appeared."¹⁷⁶ The elements of an acceptable revision of a collective work under §201(c) provides that a new work must be recognizable as a version of a preexisting collective work to be fairly characterized as a revision of that "collective work."¹⁷⁷ The Court clarified how a work, comprised of individually copyrighted works can be revised without alteration of the separate component works.¹⁷⁸ The Court stated that collective works are found to "possess distinguishing original characteristics of their own, i.e., they are greater than the sum of their parts."¹⁷⁹

The Copyright Act defines collective works as a type of compilation, a work composed of preexisting materials that are selected, coordinated or arranged in a manner which represents an original work of authorship.¹⁸⁰ However, not all collective works are compilations. Some compilations consist of pure factual information that, regardless of how it is arranged or presented, cannot be copyrighted.¹⁸¹ It is a "bedrock principle of copyright" that no author may possess a copyright of facts.¹⁸² A compilation is "a work formed by the collection and assembling of preexisting

173. *Id.* at *17.

174. 17 U.S.C. § 101.

175. *Tasini*, 1997 WL 466520, at *16.

176. *Id.*

177. 17 U.S.C. § 201(c).

178. *Tasini*, 1997 WL 466520, at *16.

179. *Id.* at *17.

180. 17 U.S.C. § 101.

181. *Tasini*, 1997 WL 466520, at *17.

182. *Id.*

materials or data that are selected, coordinated, or arranged in such a way that the resulting work as a whole constitutes an original work of authorship.¹⁸³ A telephone book is a common example of a compilation.¹⁸⁴ It is composed of facts, published logically by alphabetical order.¹⁸⁵ However, the “author” of a telephone book does not impart an element of creativity, thought or ingenuity in the arrangement of the information compiled, and therefore, cannot claim to own the work under the Copyright Act.¹⁸⁶

A collective work includes “a work such as a periodical issue, anthology, or encyclopedia, in which a number of contributions, constituting separate and independent works in themselves, are assembled into a collective whole.”¹⁸⁷ Newspapers or magazines are of a distinct type of collective work provided by the Copyright Act. “The New York Times perhaps even represents the paradigm, the epitome of a publication in which selection alone reflects sufficient originality to merit copyright protection.”¹⁸⁸

Identifying ‘all the news that’s fit to print’ is not nearly as mechanical... a task as gathering all the phone numbers from a particular region. Indeed recognizing matters of interest to readers is a highly subjective undertaking, one that different editors and different periodicals undoubtedly perform with varying degrees of success.¹⁸⁹

The crucial distinction between compilations and collective works lies in the fact that collective works are made of separate and independent works protected as the original contributions of individual authors.¹⁹⁰ In other words, the creators of collective works are entitled to rights in those works only to the extent that

183. 17 U.S.C. § 101.

184. *Tasini*, 1997 WL 466520, at *17.

185. *Id.*

186. *Feist*, 499 U.S. at 358-359 (finding that while the plaintiff’s white pages were “entirely typical,” not every selection, coordination or arrangement will pass muster).

187. 17 U.S.C. § 101.

188. *Tasini*, 1997 WL 466520, at *17.

189. *Id.* at *20.

190. 17 U.S.C. § 101.

they have demonstrated creativity in selecting and arranging preexisting material into an original collective whole.¹⁹¹ Publishers can narrowly revise their collective works in accordance with certain limitations. Publishers are not permitted to place the writers' articles into "new anthologies" or "entirely different magazines or other collective works" aside from the collective works in which the article first appeared.¹⁹² The publishers' revisions must preserve the distinguishing original characteristic or "defining element" of the original collective works.¹⁹³ They must ensure that the original characteristic is prevalent in the resulting revision in order to be protected within the privilege to reproduce and revise its copyrighted work.¹⁹⁴

The authors of collective works must also be aware of the dangers in taking independently authored original works and, by instilling an essential original element, create a derivative work from the original.¹⁹⁵ Derivative works are so closely related to collective works, that professionals in the publishing industry must recognize the caveat that careless revision of an original work may result in the creation of a derivative work constituting copyright infringement.¹⁹⁶

E. Holding

The Court held the defendants were within their legal right to make the electronic revision under § 201(c) and the electronic database companies were transferred this right under full authority of the Copyright Act. The Court seemed to reason that the publishers had a right to electronically "preserve" their works in new ways aided with new efficiency in the interest of the public's accessibility to a wide range of writer's articles.¹⁹⁷ Moreover, the court found that the defendants' electronic reproductions served the same basic function as newspapers and magazines, each as sources

191. *Tasini*, 1997 WL 466520, at *17.

192. *Id.* at *18.

193. Loundy, *supra* note 2, at 198.

194. *Tasini*, 1997 WL 466520, at *18.

195. NIMMER, *supra* note 3, § 3.02.

196. NIMMER, *supra* note 3, § 3.04[A].

197. *Tasini*, 1997 WL 466520, at *23.

of information for topics selected by the publisher defendants.¹⁹⁸ The plaintiffs were left without a substantial cause of action in obtaining an injunction against the electronic reproduction of their articles contained in defendants' collective works.¹⁹⁹

If today's result was intended, it is only because Congress could not have fully anticipated the ways in which modern technology would create such lucrative markets for revisions, it is not because Congress intended for the term revision to apply any less broadly than the court applies it today.... Plaintiffs' real complaint lies in the fact that modern technology has created a situation in which revision rights are much more valuable than anticipated at the time when the specific terms of the Copyright Act were being negotiated. Congress is of course free to revise that provision to achieve a more equitable result.²⁰⁰

The court opined that it did not take lightly the potential deprivation of rights to authors resulting from this holding, but justified this result with the only law it is given to interpret, the Copyright Act.²⁰¹

IMPACT

I. Plaintiffs

In response to Judge Sotomayer's holding, Tasini claimed "the fight for a fair share continues."²⁰² The largest obstacle the plaintiffs must face, in addition to an appeal, is the proliferation of

198. *Id.*

199. *Id.* at *24.

200. *Id.*

201. *Id.*

202. Press Release, August 13, 1997, *Writers Consider Appeal, Legislative Action in wake of Copyright Lawsuit Decision* (visited August 18, 1997) (<http://www.nwaj.org/nwaj/tvt/tvtr.htm>).

“All Rights” contracts imposed by large publishers. All Rights contracts are characterized by the plaintiffs as being “like encroachments on other basic rights, they strip people of a core element of who they are, whether that be a writer, a citizen, or a working member of society.”²⁰³ The plaintiffs suggest another remedy, the Publication Rights Clearinghouse (PRC).²⁰⁴ PRC is the National Writers Union proposed solution to compensate freelance writers for the infringement of their articles and photographs.²⁰⁵ The creation of the PRC is a watershed event in the history of the NWU because it is an agency that puts money directly into the pockets of working writers.²⁰⁶ PRC facilitates the management of their members’ works when sold to be republished in other mediums. PRC gets writers to become members and grant certain licensing rights to PRC, who in turn assigns those rights to publishers for initial publication in collective works in exchange for fees.²⁰⁷ Subsequently, the publishers are expressly permitted to use electronic database companies and other media sources to make money not transferable back to original creators or PRC.

Tasini urges writers to keep in mind that Judge Sotomayer’s ruling does not deal with their works that are republished on the World Wide Web.²⁰⁸ The writer’s transfer of rights to electronic republishes to reuse their works on web pages or in chat rooms are not explicitly addressed in the court’s discussion of § 201, § 103(b) or § 204(d), although *Tasini* affects all electronic media.

II. Defendants

On its face, *Tasini* should provide some “welcome relief for the publishing community. [It] points out the continued need for clear,

203. *Id.*

204. *Welcome to the Publication Rights Clearinghouse* (last modified February 6, 1997) <<http://www.igc.apc.org/nwu/prc/prchome.htm>>.

205. *Id.*

206. *Id.*

207. *Id.*

208. Jonathan Tasini, *Writers Win Major Points, Lose on Strange Interpretation of Copyright Law* (last modified August 14, 1997) <<http://www.igc.apc.org/nwu/prc/prchome.htm>>.

written agreements in dealing with free-lancers.”²⁰⁹ However, the prominent, well-respected publisher, National Geographic, may be adversely affected by the potential future appeal of the *Tasini* holding. National Geographic is planning to market a series of CD-ROMs that will eventually include every article of every issue that the magazine has published in the last 108 years.²¹⁰ Whether National Geographic owns the copyright to each article or photograph intended to be included in the CD-ROM series is unclear. It would be a reasonable assumption that at least some of the freelance contributors retain reproduction rights and the right to be paid for further editorial use of their works.²¹¹ National Geographic’s right to electronically reproduce its issues via CD-ROM is bolstered by the initial holding in *Tasini*, but remains subject to an appeal or another district court’s interpretation of the rights to electronically revise under the Copyright Act.²¹²

Similar to the Times’ All Rights contracts, publishers will now need to overcompensate for the contracting of rights, when the earlier and easier one page and even oral contracts were sufficient.²¹³ Popular periodicals have altered their “standard” contracts, earmarking specific payments for these extra electronic bites that they want to take out of the original apple.²¹⁴ These “ultra-contracts” or “contracts from hell” prove to be necessary to protect all parties involved in the freelance writer’s engagement with periodical publishers.²¹⁵ However, the disadvantages of the installment of such practices of “acquiring all rights” can be felt on both sides.²¹⁶ The best freelancers may go elsewhere to protect the integrity of their articles which ultimately may result in the compromise of the publication’s intrinsic value. Alternatively, freelancers may be muscled by large publishing companies to surrender all ownership rights in its work for a one-time payment.

209. Ron Abramson, *Publishers Sigh With Relief After 'Tasini'*, 218 N.Y.L.J. 5, September 26, 1997, at *5.

210. Claire Safran, *Whose Work Is It Anyway?*, FOLIO: THE MAGAZINE FOR MAGAZINE MANAGEMENT, 1997 WL 2006240, September 15, 1997, at *1.

211. *Tasini*, 1997 WL 466520, at *24.

212. 17 U.S.C. § 101.

213. Safran, *supra* note 210, at *2.

214. *Id.*

215. *Id.*

216. *Id.*

Perhaps we have lost sight of the real relationship between freelance writers and publishers.²¹⁷ Commentaries inspired by *Tasini* remind us that freelance writers are not staff employees with guaranteed wages, benefits and for that matter secure work.²¹⁸

III. Changes in the Legislation

Copyright laws have been amended several times and are due for another re-evaluation in Congress.²¹⁹ Writers hope that in doing so, legislators look to the United States Constitution, Article I, § 8 which states, "Congress shall have the Power...to promote the Progress of Science and useful Arts, by securing for limited Time to Authors and Inventors the exclusive Right to their respective Writing and Discoveries." Note that publishers are not mentioned.²²⁰

International governmental agencies have been created to address the copyright and trademark issues in recognition of the inadequacies of current law such as the World Intellectual Property Organization ("WIPO").²²¹ WIPO is the international body that debates and formulates international standards for the use and protection of intellectual property.²²² Last year, the WIPO Diplomatic Conference adopted two treaties concerning the need for protecting computer programs and original databases in the global marketplace.²²³ "Both treaties include provisions which offer responses to the challenges of digital technology, particularly on the Internet. They provide an exclusive right for authors, performers, and producers of phonographs to authorize the making available of their works, performances and photographs, respectively, to the public."²²⁴ The WIPO has recently addressed

217. *Id.*

218. Safran, *supra* note 210, at *3.

219. *Id.*

220. *Id.* at 6.

221. West's Legal News 14591, 1997 WL 12502, January 1, 1997.

222. *Id.*

223. *WIPO Approves New Copyright Treaty*, 14 No. 1 COMPUTER LAW, at *29 (January 1997).

224. West's Legal News, *supra* note 221.

the need to extend or create copyright protection to owners of electronic databases. In May 1996, a bill was introduced in the United States Congress (the "Data Intellectual Property Antipiracy Act of 1996") that would create a new federal statute for database copyright protection.²²⁵ The WIPO Copyright Treaty includes provisions designed to adapt to new digital technology, particularly the Internet.²²⁶ The treaty also suggests obligations concerning technological measures of protection and electronic rights management information while addressing whether or not specific provisions are needed concerning the application of the right of reproduction concerning some transient, temporary, incidental reproductions.²²⁷

CONCLUSION

Tasini v. New York Times is inherently controversial due to the dynamics of the application of traditional Copyright Law to contemporary computer technology. Judge Sotomayer interpreted certain definitions of the Copyright Act in manner most favorable for the defendant publishers. The Court found publishers have the right to make and sell electronic copies of their periodicals and newspapers without the expressed permission of the individual articles' authors. In the absence of explicit retention of the control of the commercial re-use of an article, the court determined the Copyright Act automatically transfers the authors' privilege to sell their articles to electronic publishers to owners of the collective work. Since *Tasini*, the understanding of "North American Rights of First publication" can no longer serve as adequate protection to individual writers when contracting with publishers, effectuating far-reaching ramifications within the publishing industry. In denying the plaintiffs' relief, this opinion leaves the issue to be addressed by the legislature.²²⁸ The future contracts between writers and publishers have already suffered from the effects *Tasini*

225. *Id.*

226. *WIPO Approves New Copyright Treaty*, *supra* note 223, at *29.

227. *Id.*

228. *Tasini vs. The New York Times, What Does it Mean for Writers?* (last modified August 23, 1997) <<http://www.igc.apc.org/nwu/tvt/tvtwrit.htm>>.

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with “All Rights” contracts and “ultra contracts,” and will continue to adapt in the event of an appeal to the court’s ruling. Judge Sotomayer acknowledged that her holding “deprives plaintiffs of certain economic benefits associated with their creations,” concluding that “this does not result from any misapplication of §201(c), but from modern developments which have changes the financial landscape in publishing.”²²⁹

Dina Marie Pascarelli

229. *Tasini*, 1997 WL 466520, at *24.

